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OFFICE OF PETITIONS

In re Application of :
Markus P. Hehlen et al. :
Application No. 10/073,763 : DECISION ON PETITION
Filed: February 11, 2002 : UNDER 37 C.F.R. §1.181(A)
Attorney Docket No. 56 :
Title: INTEGRATED OPTICAL :
ISOLATOR ARRAY :

This is a decision on the petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment, filed on May 11, 2006.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed November 22, 2004, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees¹. Accordingly, the above-identified application became abandoned on February 23, 2005. A Notice of Abandonment was mailed on March 2, 2006.

With the present petition, Petitioner has alleged that the notice of November 22, 2004 was not received. A discussion follows.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. §1.181(f) sets forth, *in toto*:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months

¹ See MPEP §710.02(e).

of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP 711.03(c) sets forth, in pertinent part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS

37 C.F.R. §1.181(f) indicates that any petition submitted under this portion of the C.F.R. that is not filed within two months

of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The present petition was submitted over two months after the mailing of the notice of abandonment. As such, the present petition will be dismissed.

It is noted in passing that even if this petition were to be accepted as timely filed, it could not be granted.

Petitioner has asserted that the Office communication was not received. He has indicated that the communication of November 22, 2004 was mailed to an address in Palo Alto, and "the assignee had previously moved in June 2002 to its current address in Fremont, CA²."

Petitioner notes that the communication was returned to the Office by the United States Postal Service on December 8, 2004, and that "no attempt was made by the PTO to re-mail the Notice of Allowance³ or find Applicant's correct address until the Notice of Abandonment was mailed 15 months later⁴."

Petitioner will note that pursuant to 37 C.F.R. §1.33(a), the Office will direct all notices relating to an application to the correspondence address. As such, the communication was properly mailed to the location in Palo Alto, as instructed by Applicant. The communication was not received however, because Applicant had not been located at that address for over two years.

MPEP §601.03 sets forth, in pertinent part:

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office (emphasis added) of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

It is obvious that Applicant did not meet his responsibility of notifying the Office when the assignee moved in June of 2002. Due to the failure to meet this responsibility, the communication was not received, and the application went abandoned as a direct result of this inaction.

Petitioner has correctly stated that the Office failed to attempt to find Applicant's correct address when the notice of allowance was returned as undeliverable. The Office will not perform searches and track down applicants when they fail to meet their obligation of submitting a change of address to the

² Petition, page 1.

³ This assertion is incorrect: the notice was mailed on March 16, 2004, and was returned as undeliverable on April 9, 2004. A second notice was mailed on November 22, 2004, which was again returned as undeliverable on December 8, 2004.

⁴ Petition, page 2.

Office in a timely manner. The assignee moved in June of 2002, and failed to submit a change of address until almost four years had elapsed⁵.

CONCLUSION

For the reasons discussed above, the petition under 37 C.F.R. §1.181 must be **DISMISSED**.

Any renewed petition under 37 C.F.R. §1.181 must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181," and should only address the deficiencies noted in this decision.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b).

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail⁶, hand-delivery⁷, or facsimile⁸.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁹. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁵ A Power of Attorney was submitted on May 9, 2006.

⁶ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁷ Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

⁸ (571) 273-8300- please note this is a central facsimile number.

⁹ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).